

REMARKS

The final Office Action dated 25 June 2004 has been reviewed. Claim 2 stands cancelled without prejudice or disclaimer, claims 1, 4 and 5 are currently amended, and claims 3 and 6-15 were previously presented. Thus, claims 1 and 3-15 remain pending and are submitted for reconsideration. No new matter has been added.

The Examiner is thanked for indicating that claims 4-11 and 15 recite allowable subject matter. The rejections under 35 U.S.C. § 112 have been overcome as discussed hereinafter, therefore it is respectfully submitted that claims 4-11 and 15 are allowable.

Summary of the Office Action

Claims 1 and 3-15 are currently pending, of which claims 1 and 4 are independent.

Claim 2 was previously cancelled without prejudice or disclaimer.

Claims 1 and 3-14 were rejected under 35 U.S.C. § 112, first paragraph.

Claims 1 and 3-14 were rejected under 35 U.S.C. § 112, second paragraph.

Claims 1, 3 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,685,981 to Jones.

Claims 1, 3 and 12-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,078,686 to Karesh in view of Jones.

The Claims are Patentable Under 35 U.S.C. § 112

Claims 1 and 3-14 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Further, claims 1 and 3-14 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. These rejections are respectfully traversed in view of the following comments.

Section 1 of the Office Action includes the assertion that the invention recited in claim 1 is contradictory to the specification. In particular, the Office Action asserts that page 7, lines 8-18, of Applicants' specification allegedly contradict Applicants' claim 1. Moreover, the Office Action asserts a new matter rejection. These assertions are respectfully traversed in view of the following comments.

Independent claims 1 and 4 recite different combinations of features that include a "closure device comprises a at least one rigid peripheral support structure attached to which is the closure mechanism that is comprised of elastically deformable elastic bands which intersect

each other and surround ... a closure member.” Thus, Applicants’ container includes a closure device to which is attached a closure mechanism, which includes a closure member and elastic bands. It is respectfully submitted that support for these combinations of features may be found in Applicants’ specification and drawings as originally filed. For example, Applicants’ describe and show a preferred embodiment of a container 1 that includes a closure device 10 (page 6, lines 1-7; Figure 1), to which is attached a closure mechanism including a closure member/sleeve 60 (page 6, line 38, to page 7, line 6; Figures 5-7) and elastic bands 40 (page 6, lines 14-26; Figures 2 and 3).

With continued reference to Applicants’ specification and drawings as originally filed, the elastic bands 40 cooperate with each other to define the opening 45 through which the sleeve 60 extends (Figures 3, 6 and 7; *see* page 3, lines 21-26). Moreover, the same preferred embodiments describe and show “each end of the sleeve 60 [i.e., end 62 fixed to ring 50 and end 64 fixed to ring 30] is folded out on each side of its middle part M” (page 7, lines 18-22). Thus, the middle part M of the sleeve 60 is surrounded by the elastic bands 40, i.e., by virtue of the elastic bands 40 defining the opening 45 through which the sleeve 60 extends, AND the sleeve 60 enfolds the elastic bands 40, i.e., by virtue of the sleeve 60 being folded over so as to extend from the middle part M to the ends 62,64 fixed to the rings 30,50.

It is respectfully submitted that Applicants’ have fully complied, both in this reply and the Amendment and Request for Reconsideration, filed 6 April 2004, with the guidelines provided in M.P.E.P. §§ 2163, 2163.06 and 2163.07. Specifically, Applicants have with particularity pointed out support in the specification as originally filed for the claimed invention, and thereby have demonstrated both that the Applicants had possession of the claimed invention at the time of the invention and that no new matter has been added.

The Office Actions dated 25 June 2004 and 17 December 2003 have both asserted contradictions between Applicants’ claimed invention and the same portion of Applicants’ specification as originally filed, i.e., page 7, lines 8-18. In the earlier Office Action, with reference to that portion of Applicants’ specification, it is asserted that “[i]t is here that a sleeve is described as surrounding the elastic members,” while questioning “[w]hat is the closure member and how do the elastic bands surround it?” The current Office Action asserts that “[s]ince the sleeve is the closure member it cannot be surrounded by the elastic bands as set forth in the claims,” and again questions “[w]hat is the closure member? and how do the elastic bands

surround it?” In rebuttal to these erroneous assertions, and to reiterate and summarize the above comments as well as those in the 6 April 2004 Amendment and Request for Reconsideration, Applicants’ specification as originally filed states:

- 1) “the closure member will be a sleeve made of flexible material having a diameter and a length of at least twice this diameter, each end of which sleeve passes through each pair of elastic bands approximately in the center of the ring where it is contracted radially in the closed rest state of the device” (page 4, lines 1-7), and according to Applicants’ preferred embodiment, “[t]he sleeve 60 acts as a closure member when working with the elastic bands 40”(page 7, lines 4-6).
- 2) “the closure device closure device will comprise at least one rigid peripheral support structure to which are attached the elastically deformable means which intersect each other and surround a closure member in such a way as to tend to close it” (page 3, lines 21-26), “the elastically deformable means may be elastic bands attached in groups of two juxtaposed elastic bands fixed to the ring at their diametrically opposed ends” (page 2, lines 35-38), and “the sleeve being contracted approximately in a middle zone between each pair of elastic bands” (page 4, lines 16-18). According to Applicants’ preferred embodiment, “elastic bands 40 are slightly stretched in their inactive state and intersect each other roughly in the center C of the ring 30” (page 6, lines 21-25), “[i]n Figure 3 it can be seen how these elastic bands 40 can move apart during the introduction of an object (not shown) between each pair of elastic bands, in such a way as to define a through opening 45” (page 6, lines 30-33), “[t]he sleeve 60 then passes through the center C of the first ring 30 and passes between each pair of elastic bands 40. It is at this location, roughly in the middle part M of the sleeve, that its diameter D is restricted by the elastic bands 40” (page 7, lines 12-17), and “Figure 7 shows how the middle part M of the sleeve 60 draws back as an object 100 passes through, pushing the elastic bands apart. The opening 45 therefore expands for as long as the object is passing through the sleeve” (page 7, lines 34-38).

As such, it is respectfully submitted that for at least these reasons, claims 1 and 3-14 fully satisfy 35 U.S.C. § 112, and that the rejections under 35 U.S.C. § 112, first and second paragraphs, are in error and should be withdrawn.

Nevertheless, in order to advance prosecution, Applicants have proposed amending claims 1 and 4 so as to correlate “a sleeve having a diameter” with the closure member. Support for the proposed amendments may be found in Applicants’ specification as originally filed, for example, at page 7, lines 4-6. It is respectfully submitted that no new matter is added, and that the claims are not narrowed by these amendments.

The Claims are Patentable Under 35 U.S.C. § 103

Claims 1, 3 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,685,981 to Jones. And claims 1, 3 and 12-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,078,686 to Karesh in view of Jones. These rejections are respectfully traversed in view of the following comments.

Claims 1 and 4 recite combinations of features that include “elastically deformable elastic bands which intersect each other and surround a sleeve,” the “sleeve having a diameter and forming a closure member,” and “the diameter of the sleeve is restricted by the elastic bands so that the closure member is closed.” With reference to the Applicants’ specification and drawings as originally filed, the elastic bands 40 cooperate with each other to define the opening 45 through which the closure member 60 extends (*see* Figure 6, for example).

Jones shows in Figures 5 and 6, and states in column 3, lines 44-47 and 54-56, that “[i]t is, therefore, desirable to further tension the wires in order that they will be held straight and against substantial flexing relative to one another...by forcing member 14 to move in perpendicular relation to the plane of strands 9.” The Office Action acknowledges that “the wire members of the closure device are not considered elastically deformable” and alleges that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to use an elastic band, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.” The rejections under 35 U.S.C. § 103(a) in view of Jones are respectfully traversed in view of the following comments.

Applicants respectfully submit that “intended use” in the sense of suitability for an intended purpose, as it is discussed in M.P.E.P. § 2144.07, refers to the “intended use” proscribed by the prior art. In contrast, the Office Action improperly alleges that it would have been obvious to substitute a different known material, based solely on one or more perceived

characteristics of the different known material, regardless of the effect that the substitution would have on the intended purpose or principle of operation of the prior art. Section 2143.01 of the M.P.E.P. reminds us that “[if a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).” And “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).” Moreover, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Given that Jones states the desirability of the wires being “held straight and against substantial flexing relative to one another” (column 3, lines 43-47) and “[t]he tensioned strands will be firm to provide a rigid support on the rim for forming an ash tray cover” (column 3, lines 63-65), it is respectfully submitted that the modification of Jones proposed in the Office Action would render Jones unsatisfactory for its intended purpose and would change the principle of operation of Jones. Moreover, Jones not only fails to suggest the desirability of the modification proposed in the Office Action, it is respectfully submitted that Jones teaches against the proposed modification.

For at least these reasons, it is respectfully submitted that the rejection of claim 1 under 35 U.S.C. § 103(a) in view of Jones should be withdrawn, and the claim allowed.

Claims 3 and 14 depend from claim 1, and therefore recite the same allowable combination of features, as well as reciting additional features that further distinguish over Jones. Therefore, it is respectfully submitted that the rejections of claims 3 and 14 under 35 U.S.C. § 103(a) over Jones should also be withdrawn, and these claims also be allowed.

Turning now to the combination of Jones and Karesh, the Office Action apparently relies on Karesh to allegedly teach or suggest closure devices at each end of a container. The Office Action fails to indicate that Karesh in any way overcomes the disadvantages of Jones described hereinabove. Karesh’s Figures 1 and 2 show, and Karesh states in column 1, lines 54-55, that a “screw cap 26 (metal or plastic) is provided at each end of the container.” Therefore, neither

Jones nor Karesh, whether considered alone or in combination, teaches or suggests the claimed combination of features recited in Applicants' claim 1.

For at least these reasons, it is respectfully submitted that the rejection of claim 1 under 35 U.S.C. § 103(a) over Karesh in view of Jones should be withdrawn, and the claim allowed.

Claims 3 and 12-14 depend from claim 1, and therefore recite the same allowable combination of features, as well as reciting additional features that further distinguish over Karesh in view of Jones. Therefore, it is respectfully submitted that the rejections of claims 3 and 12-14 under 35 U.S.C. § 103(a) over Karesh in view of Jones should also be withdrawn, and these claims also be allowed.

CONCLUSION

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing all pending claims in condition for allowance. Applicants submit that the claim amendments do not raise new issues or necessitate additional search of the art by the Examiner.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite the prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Date: 23 December 2004

by:



Scott J. Anchell

Reg. No. 35,035

CUSTOMER NO. 09629

MORGAN, LEWIS & BOCKIUS LLP

1111 Pennsylvania Avenue, N.W.

Washington, D.C. 20004

Telephone: (202) 739-3000

Facsimile: (202) 739-3001